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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/608,190	06/30/2003	Kazuya Hisada	2003_0886A	8778

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EXAMINER

SCHATZ, CHRISTOPHER

ART UNIT PAPER NUMBER

1733

DATE MAILED: 01/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/608,190

Applicant(s)

HISADA ET AL.

Examiner

Christopher T. Schatz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/9/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 22, 23, 25- 29, and 31-36, 40-43, and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maruyama et al. '133 in view of Ohno et al. '170.

Maruyama et al. discloses a method for manufacturing an optical data recording medium, said method comprising: preparing a first substrate 8; coating the first substrate with a radiation curable resin 5'; preparing a second substrate having a groove or lands and pits on one side 9; disposing a resin material 4' to the side of the second substrate having the groove or lands and pits; and pressing the radiation curable resin of the first substrate and the resin material of the second substrate together (figure 2 (f')-(h')) (column 7, line 38 – column 9, line 40). Maruyama et al. reference is silent as to the step of partially curing a radiation curable resin.

Ohno et al. discloses a method of manufacturing an optical data recording medium wherein a radiation curable resin 211 is partially cured (figure 12B, column 15, lines 51-58). Partially curing the radiation curable adhesive is advantageous because, as disclosed by Ohno et al. doing so increases the thickness uniformity of the resin layer,

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thus preventing the recording and playback signals from varying (column 4, lines 54-59). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to partially cure a radiation curable resin as taught by Ohno et al. above to increase thickness uniformity in the process of manufacturing an optical data recording medium as set forth above by Maruyama et al.

3. Claims 22-36, 40-43, and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maruyama et al. in view of Amo '433 for the same reasons presented in paragraph 7 of examiner's office action dated August 1, 2005.

4. Claims 37-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maruyama et al. and Amo as applied to claims 22 and 33 above, and in further view of Ohki et al, '652 for the same reasons presented in paragraph 8 of examiner's office action dated August 1, 2005.

5. Claims 44 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maruyama et al. and Amo as applied to claims 22, 26, 43, and 45 above, and in further view of Komaki et al. (US 2001/0053121) for the same reasons presented in paragraph 9 of examiner's office action dated August 1, 2005.

Response to Arguments

Applicant's arguments filed on November 1, 2005 have been fully considered but they are not persuasive. First, applicant should note that *none of the claims, as written, require that the partial curing step occur before the substrates are pressed together*. Claim 22 simply presents a set of steps, but never requires that said steps occur in any specific order. Furthermore, none of the other claims require that the steps of claim 22

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occur in any specific order. While applicant cites the specification and argues that the invention is directed toward a method wherein the substrates are laminated after partial curing occurs, this argument is not commensurate with applicant's claims. As such, even in a hypothetical situation where it is not obvious to preform partially curing before the pressing of the two substrates, the references meet the limitations of the claims *as currently written*. Furthermore, examiner acknowledges that if applicant were to amend the claims properly such that the claims required the partially curing step to occur before the pressing step, the combination of Maruyama et al. in view of Ohno et al. would not render such a limitation obvious. However, examiner asserts Maruyama et al. in view of Amo et al. would render the limitation of curing before pressing obvious.

Applicant states that "Amo discloses only a temporary fixing step by partial irradiation after lamination two substrates together, and partial irradiation after lamination cannot cause the thickness uniformity of the resin layer to be increased." Applicant should note that examiner never stated that Amo increases uniformity thickness. Rather, the advantage of the partially curing step of Amo is that misaligned substrates can properly be aligned. Applicant then states that because Amo is directed toward a method for curing the nonalignment in the center of a storage disk, it does disclose or even suggest changing the timing of partially curing a radiation curable resin to before the pressing step. First, applicant should take note that it is *because of the partially curing step* that misalignment is prevented (column 8, lines 25-35). Additionally, applicant should note that while Amo discloses a *placing* step before the partial curing of the resin, a step of *pressing* the radiation curable resin together between the two substrates after partially curing is not excluded by Amo and well within the

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purview of one of ordinary skill in the art. In fact, as disclosed in the column 8 text cited above, the advantage of partially curing before pressure is exerted upon either one of said substrates is that said substrates do not misalign when force is applied. Such a disclosure supports examiner's position taken in paragraph 7 of the office action dated August 1, 2005 – that the advantage of preventing non-alignment of the substrates would be realized regardless of when partially curing occurs.

As to Ohki et al. and Komaki et al., applicant states that neither reference discloses “curing a radiation curable adhesive before the first and second substrates are pressed together as recited in claim 7.” Applicant should note that no claim 7 is currently presented in the application. Examiner will assume, for the purpose of this office action, that applicant is actually referring to claim 22. Examiner asserts that it is not necessary for Ohki et al. and Komaki et al. to disclose said partial curing, since claim 22 as written does not require a curing step before a pressing step for the reasons discussed above. Furthermore, even if applicant were to amend claim 22 to require said curing step to occur before said pressing step, it is not necessary for Ohki et al. and Komaki et al. to disclose said limitation since the combination of Maruyama et al. and Amo et al. render said limitation obvious for the reasons presented above. Applicant is reminded that a reference need not disclose every limitation of a claim in order to render it obvious under U.S.C. 103(a), as long as there is a motivation to combine the references used. Applicant further argues “that a person having ordinary skill in the art at the time the invention was made would not have been motivated to modify Maruyama et al., Ohno et al., Amo, Ohki et al. and Komaki et al. in such as manner as to result in, or otherwise render obvious, the

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present invention as recited in claim 22.” Examiner asserts that the combination of Maruyama et al. and Amo, for the reasons presented above, render claim 22 obvious.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Christopher T. Schatz** whose telephone number is **571-272-1456**. The examiner can normally be reached on 8:00-5:30, Monday -Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Richard Crispino can be reached on 571-272-1226. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CTS



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